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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/010,497

12/03/2001

Arturo A. Rodriguez

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05/28/2004

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

STORM, DONALD L

ART UNIT

PAPER NUMBER

2654

7

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,497

Applicant(s)

RODRIGUEZ ET AL

Examiner

Donald L. Storm

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004 and 22 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,52,58-60,62,67,86,87,89-95 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18,58-60,62,67,91-93 and 97 is/are allowed.
- 6) ☒ Claim(s) 52 is/are rejected.
- 7) ☒ Claim(s) 86,87,89,90,94 and 95 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indication of allowable subject matter in claim 52 is withdrawn in view of the newly discovered reference(s) of Menard. Rejections based on the newly cited reference(s) follow. The Examiner apologizes for prematurely indicating allowable matter and the belated discovery of grounds for rejection.
2. Claims 18, 58-60, 62, 67, 91-93, and 97 are allowed. Claims 86-87, 89-90, and 94-95 recite allowable subject matter.

Claim Informalities

3. Claims 86-87, 89-90, and 94 are objected to under 37 CFR 1.75(a) because the meaning of the following phrase needs clarification: the at least on function.
4. Claim 95 is objected to under 37 CFR 1.75(a) because the meaning of the phrase "the unwanted signals" needs clarification. Because no unwanted signals were previously recited, it may be unclear as to what element this phrase refers. To further timely prosecution and evaluate prior art, the Examiner has interpreted this phrase to refer to the unwanted signals that are recited in the next line of the claim, comprised in the encoded digitized signals.
5. The Examiner notes, without objection, the possibility of informalities in the claims. The Applicant may wish to consider changes during normal review and revision of the disclosure.

In claim 94, the phrase "a the audio signals" (next to last line) may be unintended.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Menard

7. Claim 52 is rejected under 35 U.S.C. 102(e) as being anticipated by Menard [US Patent Application Publication 2003/0013503].

8. Regarding claim 52, Menard [at 0053] describes an embodiment consisting of compatible intercom units, one device functioning as a remote control of the other. For the remote controller device, Menard describes the content and functionality of the recited limitations recognizable as a whole to one versed in the art as the following terminology:

first microphone [at claim 19, as microphone proximate remote audio];

processor for digitizing the microphone input [at 0038, as analog to digital converter];

transmitter for wirelessly transmitting digitized input to a device associated with a remote control apparatus [at claim 19, as processor to wirelessly transmit digital data (based on remote audio) to be received by local device receiving digital data];

enable microphone function that activates that first microphone to receive input [at 0020, as control switch illustrated as a push-to-talk (PTT) switch];

the enable microphone function is a two position on/off switch [at 0024, as switch may be a toggle switch].

Response to Arguments

9. The prior Office action, mailed December 17, 2003 (paper 4), objects to the specification and claims, and rejects claims under 35 USC § 102 and § 103, citing Houser and others. The Applicant's arguments and changes in RESPONSE TO OFFICE ACTION (WITH AMENDMENTS) filed March 22, 2004 (paper 6) have been fully considered with the following results.

10. With respect to objection to the specification as lacking proper antecedence for claimed matter, the changes entered by amendment claim subject matter that can be identified in the specification. Accordingly, the objection is removed.

11. With respect to objection to the claims dependent upon rejected base claims, the claims are no longer dependent. Accordingly, the objections are removed.

12. With respect to objection to claims 5, 6, 12, 22, 23-30, 37, 38, 76-85, and 88 as needing clarification, the objections no longer apply because those claims have been canceled.

13. With respect to objection to claims 86-87, 89-90, and 94 as needing clarification, the Applicant's arguments appear to be that the claims were amended for clarity. This argument is not

persuasive because the amended phrase is not in the claims. Accordingly, the objections are maintained.

Conclusion

14. The following references here made of record are considered pertinent to applicant's disclosure:

Cuijpers et al. [US Patent 6,462,664] describes a remote control embodiment that activates a microphone function by a two-position switch.

15. Any response to this action should be mailed to:

Commissioner for Patents
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Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

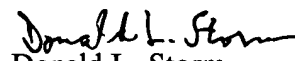
Or:

(703) 872-9306, (for informal or draft communications, and please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Plaza Two, Lobby, Room 1B03, 2011 South Clark Place, Arlington, VA

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Storm, of Art Unit 2654, whose telephone number is (703) 305-3941. The examiner can normally be reached on weekdays between 8:00 AM and 4:30 PM Eastern Time. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil can be reached on (703) 305-9645.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov.


Donald L. Storm
May 24, 2004


RICHEMOND DORVIL
SUPERVISORY PATENT EXAMINER